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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,594	07/10/2006	**Hirokazu Taniguchi**	52433/852	4328

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EXAMINER	
YANG, JIE	

ART UNIT	PAPER NUMBER
1733	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/585,594	TANIGUCHI ET AL.	
	Examiner	Art Unit	
	JIE YANG	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2011*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim 1 has been amended, claims 2-7 are cancelled, claim 8 is added as a new claim, and claims 1 and 8 are pending in application.

Status of the Previous Rejection

The previous rejections of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Masaaki et al (JP 2003105491 A1, thereafter JP'491) in view of EP'346 is withdrawn in view of the amendment and the Applicant's remark filed on 1/12/2011.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al (EP 1 160 346 A1, thereafter EP'346) in view of Kashima et al (US 7,090,731 B2, thereafter US'731).

EP'346 in view of US'731 is applied to claim 1 for the same reason as stated in the previous office actions marked 7/13/2010. The amendment for typo error in claim 1 does not change the scope of the instant claim.

Regarding the newly added claim 8, the further process limitations of pickling and pre-plating after cooling to the martensite transformation point in the instant claim are recognized as process limitations in a product-by-process claim. In the absence of structural characteristics imparted by the claimed process limitations, the claimed processes (pickling and pre-plating) would not add a patentable weight to the instant product claim. MPEP 2113 R1.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 8 are provisionally rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-7 of copending application No. 10/560989 in view of US'731.

Claims 1-7 of copending application No. 10/560989 in view of US'731 is applied to the instant claim 1 for the same reason as stated in the previous office actions marked 7/13/2010. The amendment for a typo error in claim 1 does not change the scope of the instant claim.

Regarding the newly added claim 8, the further process limitations of pickling and pre-plating after cooling to the martensite transformation point in the instant claim are recognized as process limitations in a product-by-process claim. In the absence of structural characteristics imparted by the claimed process limitations, the claimed processes (pickling and pre-plating) would not add a patentable weight to the instant product claim. MPEP 2113 R1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 and 8 are provisionally rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-8 of copending application No. 10/558579 in view of US'579.

Claims 1-8 of copending application No. 10/558579 in view of US'731 is applied to the instant claim 1 for the same reason as stated in the previous office actions marked 7/13/2010. The amendment for typo error in claim 1 does not change the scope of the instant claim.

Regarding the newly added claim 8, the further process limitations of pickling and pre-plating after cooling to the martensite transformation point in the instant claim are recognized as process limitations in a product-by-process claim. In the absence of structural characteristics imparted by the claimed process limitations, the claimed processes (pickling and pre-plating) would not add patentable weight to the instant product claim. MPEP 2113 R1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 and 8 are provisionally rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-3 of copending application No. 10/591919 in view of US'731.

Claims 1-13 of copending application No. 10/591919 in view of US'731 is applied to the instant claim 1 for the same reason as stated in the previous office actions marked 7/13/2010. The amendment for a typo error in claim 1 does not change the scope of the instant claim.

Regarding the newly added claim 8, the further process limitations of pickling and pre-plating after cooling to the martensite transformation point in the instant claim are recognized as process limitations in a product-by-process claim. In the absence of structural characteristics imparted by the claimed process limitations, the claimed processes (pickling and pre-plating) would not add a patentable weight to the instant product claim. MPEP 2113 R1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed on 1/12/2011 with respect to claim 1 under 35 U.S.C. 103(a) as being unpatentable over EP'346 in view of US'731 have been fully considered but they are not fully persuasive. Regarding the Applicant's arguments related to the amended feature in the instant claims, the Examiner's position is stated as above.

The Applicant's arguments are summarized as following;

Regarding the rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over EP'346 in view of US'731, EP'346 does not teach 3.5-10% of tempered martensite in the steel. US'731 does not cure the deficiencies in EP'346 and sample 15 in table 39 is a comparative example which US'731 clearly discloses it does not have the desired properties.

In response,

Regarding the Applicant's argument, the Applicant's argument is against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, EP'346 in view of US'731 is applied to claims 1 and 8. The detail discussions and motivations for combining these references can refer to the discussion above and the previous office action marked 7/13/2010. As pointed out in the previous office action marked 7/13/2010, US'731 teaches controlling the retained austenite and the tempered martensite or tempered

bainite by heating, cooling, holding, and further cooling processes (Fig.8A, 9-12 and tables for example table 38-39 of US'731). More specifically, US'731 teaches steel microstructure with 10% tempered martensite and 5% retained austenite (sample 15 in table 39 of US'731), which is within the claimed ranges of the tempered martensite and the retained austenite as recited in the instant claim and US'731 teaches that the sample 15 of table 39 has the properties of tensile strength of 730MPa and elongation 34%, which are compatible with the properties of invention samples in the table 3 and 7 of the instant specification. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to control the microstructure of the galvanized steel through the heat treating process as demonstrated by US'731 for the steel of EP'346 in order to obtain a steel with both high strength and excellent formability (Col.1, lines 7-19 of US'731).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/ Roy King/
Supervisory Patent Examiner, Art Unit 1733